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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,277	02/14/2001	Richard Naylor	10335-004	8370

20582 7590 10/04/2005

JONES DAY

51 Louisiana Aveue, N.W

WASHINGTON, DC 20001-2113

EXAMINER

HAMILTON, LALITA M

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/782,277

Applicant(s)

NAYLOR ET AL.

Examiner

Lalita M. Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brett (6,907,405) in view of Schneck (6,314,409).

Brett discloses a method and corresponding computer software for auctioning priority rights comprising receiving at least product from each of a plurality of sellers, transmitting a version of at least one product to a plurality of bidders, offering for sale at least one category of available priority rights representing a scope of use of the product, receiving a plurality of bids for said at least one category of priority rights, determining at least one buyer, based on said plurality of bids, and transmitting the product to said at least one buyer (col.1, line 23 to col.2, line 20; col.3, lines 35-56; and col.9, line 30 to col.10, line 60); least one category comprises an exclusive right to display the product

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and said buyer is determined based on the highest bid received (col.1, line 23 to col.2, line 20; col.3, lines 35-56; and col.9, line 30 to col.10, line 60); said at least one category comprises a non-exclusive right to display the product and said at least one buyer is determined by calculating a maximum revenue from selling to a one or more of the bidders at the bid price offered by the lowest of said at least one buyer (col.1, line 23 to col.2, line 20; col.3, lines 35-56; and col.9, line 30 to col.10, line 60); receiving from each seller information which defines the rights under which a seller may display the product (col.1, line 23 to col.2, line 20; col.3, lines 35-56; and col.9, line 30 to col.10, line 60); plurality of categories of available priority rights are offered, and the categories comprise at least one first category comprising an exclusive priority right and at least one second category comprising a non-exclusive priority right (col.1, line 23 to col.2, line 20; col.3, lines 35-56; and col.9, line 30 to col.10, line 60); receiving at least one bid for each of said first and second categories and comparing a winning bid for selling the priority right on an exclusive basis with a total amount of revenue to be received by selling the priority right on a non-exclusive basis at the bid price offered by the lowest of the successful bids and determining said at least one buyer based on the outcome of the comparison (col.1, line 23 to col.2, line 20; col.3, lines 35-56; and col.9, line 30 to col.10, line 60); the available priority rights representing a scope of use of the product comprises a plurality of exclusive rights to display in printed or electronic media within a specific geographic location, exclusive rights to display in printed or electronic media during one or more time periods, exclusive rights to display in printed media in predetermined number of publications, exclusive rights to display in media of a certain

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language, or combinations thereof (col.1, line 23 to col.2, line 20; col.3, lines 35-56; and col.9, line 30 to col.10, line 60); the available priority rights representing a scope of use of the product comprises a plurality of: non-exclusive rights in printed or electronic media within a specific geographic location, non-exclusive rights to display in printed or electronic media during one or more time periods, non-exclusive rights to display in printed media in a predetermined number of publications, non-exclusive rights to display in media of a certain language, or combinations thereof (col.1, line 23 to col.2, line 20; col.3, lines 35-56; and col.9, line 30 to col.10, line 60); available priority rights representing a scope of use of the product comprises both exclusive and non-exclusive rights, wherein at least some of the offered rights are conflicting rights, wherein there are one or more bids on at least one pair of conflicting rights, and wherein the buyer or buyers are determined by the electronic marketplace and are the bidder or bidders of non-conflicting rights that result in the greatest revenue (col.1, line 23 to col.2, line 20; col.3, lines 35-56; and col.9, line 30 to col.10, line 60); receiving at least one product from each of a plurality of sellers, transmitting a version of at least one product to a plurality of bidders, offering for sale at least one category of non-exclusive priority rights representing a scope of use of the product comprises transmitting a price of the non-exclusive right, receiving a plurality of bids from buyers for said at least one category of display rights, changing the price by a pre-selected amount depending on the quantity sold within a pre-selected time interval, and transmitting the product to buyer whose bids were accepted (col.1, line 23 to col.2, line 20; col.3, lines 35-56; and col.9, line 30 to col.10, line 60); the price increases by a first pre-selected amount if a first pre-

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selected quantity of bids the price decreases by a second pre-selected amount if a second pre-selected quantity of bids are not accepted within a pre-selected time interval, and stopping decreasing the price is displayed (col.1, line 23 to col.2, line 20; col.3, lines 35-56; and col.9, line 30 to col.10, line 60); and the first pre-selected quantity does not equal the second pre-selected quantity, wherein the price does not change if the number of bids accepted is between the first pre-selected quantity and the second pre-selected quantity (col.1, line 23 to col.2, line 20; col.3, lines 35-56; and col.9, line 30 to col.10, line 60). Brett does not specifically disclose the priority to obtain a digital image or display rights. Schneck teaches a method and corresponding computer program for controlling access and distribution of digital property comprising digital images and display rights (col.2, lines 45-65 and col.7, lines 15-65). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate digital images and display rights, as taught by Schneck into the invention disclosed by Brett, as an alternative type of priority right that may be auctioned.

Provisional Application Listed on PTO-892 form

If a copy of a provisional application listed on the bottom portion of the accompanying Notice of References Cited (PTO-892) form is not included with this Office action and the PTO-892 has been annotated to indicate that the copy was not readily available, it is because the copy could not be readily obtained when the Office action was mailed. Should applicant desire a copy of such a provisional application, applicant should promptly request the copy from the Office of Public Records (OPR) in accordance with 37 CFR 1.14(a)(1)(iv), paying the required fee under 37 CFR

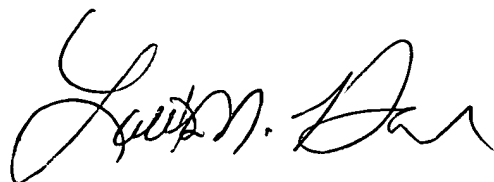
1.19(b)(1). If a copy is ordered from OPR, the shortened statutory period for reply to this Office action will not be reset under MPEP § 710.06 unless applicant can demonstrate a substantial delay by the Office in fulfilling the order for the copy of the provisional application. Where the applicant has been notified on the PTO-892 that a copy of the provisional application is not readily available, the provision of MPEP § 707.05(a) that a copy of the cited reference will be automatically furnished without charge does not apply.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M. Hamilton whose telephone number is (571) 272-6743. The examiner can normally be reached on Tuesday-Thursday (8:30-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Lalita M. Hamilton", is located at the bottom left of the page.